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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,434	12/26/2001	Yoshio Kishima	F-7266	9300
28107	7590	10/16/2003	EXAMINER	
JORDAN AND HAMBURG LLP 122 EAST 42ND STREET SUITE 4000 NEW YORK, NY 10168			MARTIR, LILYBETT	
			ART UNIT	PAPER NUMBER
			2855	

DATE MAILED: 10/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/033,434

Applicant(s)

KISHIMA ET AL.

Examiner

Lilybett Martir

Art Unit

2855

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6. 6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1,3,5 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- With respect to claim 1, the recitation of "while a depth of the cutting blade being controlled to such a depth slightly upper than the interface that a cutting piece remains on the cutting blade" makes said claim indefinite, since it is not clearly understood what the applicant means by it's use.
- With respect to claim 5, the recitation of "a depth of the cutting blade being controlled to such a depth slightly upper than the interface that a cutting piece stays on the cutting blade" makes said claim indefinite, since it is not clearly understood what the applicant means by it's use, and also, said recitations could not be drawn by the examiner to represent any structure.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3 and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Nishiyama et al. (Pat. 4,934,185).

- With respect to claims 1 and 5, Nishiyama et al. teaches a means for inserting an edge of a cutting blade 47 into an upper layer of a structure 35 as do elements 71 and all of the elements that work in conjunction with said element that are located in top of it as noted in Figure 1 (Col. 7, lines 14-17), a means for moving the cutting blade substantially in parallel with an interface between the upper and lower layers of the structure 35 as does element 11 (Col. 6, lines 10-21) while a depth of the cutting blade is controlled (Col. 7, lines 1-15), and means for measuring a force exerted on the cutting blade substantially in parallel with the interface as in element 4.
- With respect to claims 2 and 6, Nishiyama et al. teaches a means for inserting an edge of a cutting blade 47 into an upper layer of a structure 35 as do elements 71 and all of the elements that work in conjunction with said element that are located in top of it as noted in Figure 1 (Col. 7, lines 14-17), a means for moving the cutting blade substantially in parallel with an interface between the upper and lower layers of the structure 35 as does element 11 (Col. 6, lines 10-21), means for measuring a force exerted on the cutting blade substantially in parallel with the interface as in element 4, and means for controlling the depth of the cutting blade (Col. 7, lines 1-15) where the force alternates between increase and decrease (Col. 8, lines 27-47).
- With respect to claims 3 and 7, Nishiyama et al. teaches the utilization of means for expressing the force exerted on the cutting blade substantially in parallel or vertically with the interface and the depth of the cutting blade as does element 28 in the form of a graphic profile of change with time as noted in Figures 11(a) to 11(d).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4 and 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishiyama et al. (Pat. 4,934,185).

- With respect to claims 4 and 8, Nishiyama et al. teaches the evaluation, detection and testing of films as thin as in the micrometer (μm) range (See Figures 11(a) to 11(d). Nishiyama et al. fails to disclose the specific determination of detection means to be used to detect a $2\mu\text{m}$ depth. Since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or working ranges involves only routine skill in the art (In re Aller, 105 USPQ 233), it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teachings of the measuring device of Nishiyama et al. by selecting a specific range of measurements to be detected and evaluated to therefore modify the reliability and precision of his device

Claim Objections

7. Claims 5-8 are objected to because of the following informalities: in said claim, the word apparatus has been incorrectly typed as "apparatus". Appropriate correction is required.

Art Unit: 2855

Citation of Prior Art

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art considered pertinent during examination of the examined application is:

- Kishima et al. (Pat. 5,333,494) Material strength measuring apparatus.
- Bousfield et al. (Pat. 6,050,139) Devices and methods for testing tack uniformity of a coating on a substrate.
- Mueller (Pat. 5,101,655) Apparatus and method for weatherstrip wear testing.

Conclusion


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lilybett Martir whose telephone number is (703)305-6900. The examiner can normally be reached on 9:00 AM to 5:30 PM.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Lefkowitz can be reached on (703)305-4816. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

11. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.

CM
Lilybett Martir
Examiner
Art Unit 2855

RCM


EDWARD LEFKOWITZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800